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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/770,782 | 01/26/2001 | Alexandra D. Bernel | 82111HEC | 8268 |

7590 02/11/2003
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

10
EXAMINER

SCHWARTZ, PAMELA R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1774

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-10

Office Action Summary

Application No.

09/770,782

Applicant(s)

BERMEL ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. All previous grounds of rejection have been overcome.
2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because it is unclear whether or not the binder of the claims has been cross-linked and if the binder has been cross-linked, whether applicants still intend for 20 wt% cross-linking agent (based upon the amount of binder) to remain. The examiner has reviewed the specification, but was unable to make a clear determination. Clarification is required.

If applicants intend for the binder of the final product to be cross-linked, then the claims could be clarified by stating that the image-receiving layer is "formed from" the components (rather than the current language that layer "comprises" the components). For purposes of the following rejections, the examiner will treat the binder as having been cross-linked by the cross-linking agent.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,419,355. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims recite an ink jet printing method using a medium that has a support and a base coating layer which may contain fumed alumina (cl. 11) and polyvinyl alcohol that has been cross-linked with 2,3-dihydroxy-1,4-dioxane (cl. 7 and 18). The cationic polymeric particles recited by claim 1 of the patent will act as a mordant. The patent discloses particle size in claim 1 but the claims are silent with respect to the percentage of cross-linking agent. Since applicants' claims are being interpreted as including cross-linked binder rather than unreacted binder and cross-linker, the patent claims are considered to obviate the instant claims.

Even if applicants intend to require the 20 wt% cross-linking agent prior to cross-linking, since the patent claims are silent as to how much cross-linking agent is intended to be present, it is proper to look to the specification to define this feature necessary to practice the patented invention. The ratio of 10:2, binder to cross-linker, provides the guidance to use the instantly claimed value of at least 20 weight percent cross-linking agent (see col. 7, lines 14-19).

The support material recited by claim 6 is conventional and its use would have been obvious to one of ordinary skill in the art.

4. Claims 1-8 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,497,460. Although the conflicting claims are not identical, they are not patentably distinct from

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each other because the patent claims recite an ink jet printing method using a medium that has a support and an ink retaining layer which may contain fumed alumina and polyvinyl alcohol that has been cross-linked with 2,3-dihydroxy-1,4-dioxane (cl. 1 and 10). The ink-retaining layer is disclosed as including a mordant (cl. 16). The patent discloses particle size in claim 1 but the claims are silent with respect to the percentage of cross-linking agent. Since applicants' claims are being interpreted as including cross-linked binder rather than unreacted binder and cross-linker, the patent claims are considered to obviate the instant claims.

Even if applicants intend to require the 20 wt% cross-linking agent prior to cross-linking, since the patent claims are silent as to how much cross-linking agent is intended to be present, it is proper to look to the specification to define this feature necessary to practice the patented invention. The ratio of 9:4, binder to cross-linker, provides the guidance to use the instantly claimed value of at least 20 weight percent cross-linking agent (see col. 6, lines 31-33).

The support material is recited by claim 12 as resin-coated paper and polyethylene is most commonly used for this purpose. Therefore, its use would have been obvious to one of ordinary skill in the art.

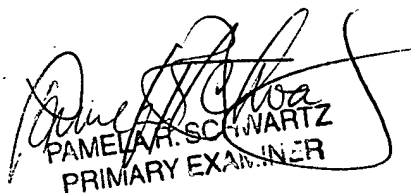
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela R. Schwartz whose telephone number is 703-308-2424. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on (703) 308-0449. The fax

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phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

PRSchwartz
February 8, 2003



PAMELA R. SCHWARTZ
PRIMARY EXAMINER